

REMARKS

The present response is submitted in reply to the Office action issued on September 16, 2009. The Applicant thanks the Examiner for entry of the previously filed Request for Continued Examination (RCE).

Claims 32-46 are pending in this application. Claims 32-44 have been rejected. The Examiner has indicated on page 5 of the Office action that claims 45 and 46 contain allowable subject matter and would be allowed if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Applicant thanks for the Examiner for this determination. By the present response, claims 47-53 have been newly added, as discussed below.

New claim 47 is based on claims 41 and 45 and includes the allowable subject matter of claim 45. Therefore, it is submitted that new claim should be allowed.

New dependent claims 52 and 54 recite the limitation of the polyethers (which had been recited in the prior independent claim) for purposes of clarity.

The remaining newly added dependent claims are based on the previously pending dependent claims. The allowable subject matter of claim 46 has been incorporated into new claim 49.

No new matter has been added. Reconsideration is respectfully requested in light of the amendments being made hereby and of the following remarks.

Rejection of claims 32-39 and 41-43 under 35 U.S.C. 102(b)

Claims 32-39 and 41-43 have been rejected under 35 U.S.C. 102(b) as being anticipated by WO 93/06144 (Gangadharan). The Examiner argues in the Office action that Gangadharan discloses adhesive products capable of use with medical patches or

transdermal therapeutic systems and that the adhesive comprises a moisture activated adhesive composition and a hydrophobic adhesive polymer core (psa polymer component), wherein the psa component can be a polyacrylate and at least one component such as polyethers and acid anhydrides including acids salts of acid anhydrides such as methylvinyl ether/maleic acid copolymers or a cellulose derivative such as carboxymethyl cellulose. Therefore, the Examiner concludes that the reference anticipates the presently claimed invention as recited in claims 32-38.

As regards claim 39, the Examiner states that the reference teaches controlling moisture and a dried product.

As regarding claims 41-43, the Examiner states that the reference teaches a polar solvent, such as water.

The Applicants respectfully disagree with the Examiner's conclusion and submit that the present invention is patentably distinct from the invention disclosed in the cited reference. In view of the newly added claims, and in particular the new independent claim 47 which incorporates the allowable subject matter of prior claim 45, it is submitted that the reference fails to teach each and every limitation of the present claims and therefore fails to anticipate the presently claimed invention. Therefore, withdrawal of the present rejection is appropriate and is respectfully requested.

Rejection of claims 40 and 44 under 35 U.S.C. 103(a)

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gangadharan in view of U.S. Publication No. 2004/0068036 (Halliday). The Examiner concludes that Gangadharan discloses the adhesive composition of claim 44, but does not

disclose the use of solvents, such as hexane and ethyl acetate. The Examiner refers to Halliday for teaching that it is known to coat compositions, wherein the coatings can be provided in a carrier liquid, such as the solvents hexane, ethyl acetate and water. The Examiner thus concludes that it would have been obvious to one having ordinary skill in the art to substitute the water solvent of Gangadharan for one of the disclosed solvents of Halliday, such as hexane or ethyl acetate, and to achieve a reasonable expectation of success, since Halliday discloses the equivalence of the solvents water, hexane and ethyl acetate, with the distinctive choice being the environment.

Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gangadharan. The Examiner concludes that Gangadharan discloses controlling moisture and a dried product, but fails to teach that the dried product is a dried film. However, the Examiner contends that it would have been obvious to one having ordinary skill in the art to provide the adhesive in any form, including a film, depending on the intended use. The Examiner also notes that varying the form/shape of the adhesive will allow the adhesive to be used differently, i.e., on different body parts or on different elements.

The Applicants respectfully disagree with the Examiner's position and submit that to establish a *prima facie* case of obviousness, three basic criteria must be met, as set forth in M.P.E.P. § 2142. First, there must be some suggestion or motivation to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As noted above regarding the anticipation rejection in view of Gangadharan, the

present invention is patentably distinct from the invention disclosed in the cited references. In particular, new independent claim 47 incorporates the allowable subject matter of prior claim 45. Therefore, the combination of teachings of Gangadharan and Halliday fail to teach each and every limitation of the presently claimed invention. Withdrawal of the present obviousness rejection is appropriate and is respectfully requested.

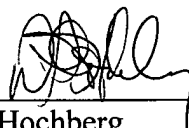
Conclusion

For the foregoing reasons, it is believed that the present application, as amended, is in condition for allowance, and such action is earnestly solicited. Based on the foregoing arguments and the deficiencies of the prior art references, the Applicants strongly urge that the obviousness-type rejection be withdrawn. The Examiner is invited to call the undersigned if there are any remaining issues to be discussed which could expedite the prosecution of the present application.

Respectfully submitted,

Date: January 19, 2010

D. Peter Hochberg Co., L.P.A.
1940 E. 6th St. – 6th Floor
Cleveland, OH 44114
Phone - (216) 771-3800
Fax – (216) 771-3804

By: 
D. Peter Hochberg
Reg. No. 24,603